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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/461,040 | 12/15/1999 | Michelle Q. Wang Baldonado | 104323 | 3267 |

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Alexandria, VA 22320

EXAMINER

NGUYEN, MAIKHANH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2176 | |

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/461,040 | BALDONADO ET AL. |
| | Examiner | Art Unit |
| | Maikhahan Nguyen | 2176 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 December 1999.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-37 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-37 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. This action is responsive to communications: original application filed 12/15/1999; IDS filed 02/07/2000.
2. Claims 1-37 are currently pending in this application. Claims 1, 14 and 26 are independent claims.

Claim Rejections - 35 USC § 112

3. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims 1, 14 and 18, the limitation “a view medium of the at least one object is distinct from the annotation device” is unclear.

The dependent claims are also rejected for fully incorporating the dependencies of their parent claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette et al.** (U.S. 5,809,318 – filed 04/1997, hereinafter Rivette318) in view of **Rivette et al.** (U.S. 6,389,434 – filed 04/1998, hereinafter Rivette434).

As to independent claim 14, Rivette318 discloses a method for associating annotations (annotations to document objects; Abstract) with at least one object comprising:

- searching for the at least one object (the search will encompass the entire patent library currently open ... Upon completion of the search ... a user may also select a save search; col.31, lines 1-29) to annotate;

- associating the at least one annotation with the at least one object identifier wherein a viewing medium of the at least one object is distinct from an annotation medium (the user may also create and manipulate notes and subnotes as annotations to document objects or document portions; Abstract).

However, Rivette318 does not explicitly disclose “obtaining an object identifier for at least one object.”

Rivette434 discloses obtaining an object for at least one object (the object identifier field 1506 ... are partitioned into the note/object; col.30, lines 43-55).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rivette434 with Rivette318 because it would have provided the enhanced capability for identifying the location of the selected portion in the data object.

As to dependent claim 15, Rivette318 discloses the annotation linking circuit establishes the link to the at least one portion based on at least one of a graphical technique and a textual technique (match text to processed image; Fig.78).

As to dependent claim 16, Rivette318 discloses the graphical technique associates the at least one annotation with at least one portion of the at least one object based on selection of at least one portion of a graphical icon that is a visual surrogate of the at least one object (Fig.80).

As to dependent claim 17, Rivette318 discloses the textual technique comprises associating the at least one annotation and at least one of a word, phrase or a portion of text (new subnotes associated with selected objects or selected portions; Abstract).

As to dependent claim 18, Rivette318 discloses the textual technique is based on a phrase completion technique (Fig.79).

As to dependent claim 19, Rivette318 does not disclose associating the object identifier and the at least one object.

Rivette434 discloses associating the object identifier and the at least one object (the object identifier field 1506 ... are partitioned into the note/object; col.30, lines 43-55).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rivette434 with Rivette318 because it would have provided the enhanced capability for identifying the location of the selected portion in the data object.

As to dependent claim 20, Rivette318 discloses retrieving supplemental information associated with the at least one object (col.31, lines 31-45).

As to dependent claim 21, Rivette318 discloses developing a digital surrogate of the at least one object (Fig.80)

As to dependent claim 22, Rivette318 discloses retrieving at least one previous annotation associated with the at least one object (col.43, lines 38-42/ col.44, lines 7-9).

As to dependent claim 23, Rivette318 discloses annotating at least one of the at least one previous annotation (col.43, lines 38-42/ col.44, lines 7-9).

As to dependent claim 24, Rivette318 discloses searching for the at least one object comprises: entering at least one of a description of the object and the object identifier; and searching at least one of a networked search engine, a personal computer and a distributed network (col.31, lines 1-29).

As to dependent claim 25, Rivette318 discloses the at least one object is at least one of a media type object, a device type object, a location type object and a digital document (variety of different types of document; col.2, lines 50-53).

Independent claim 26 is for an information storage media for implementing the method of claim 14, and is similarly rejected under the same rationale.

Dependent claims 27-30 and 31-37 include the same limitations as in claims **15-18 and 20-25**, and are similarly rejected under the same rationale.

As to independent claim 1, the rejection of claim 14 above is incorporated herein in full. However, claim 1 further recites an annotation device, the annotation device comprising:

- an input device that receives at least one annotation;
- an annotation linking circuit that establishes a link associating the at least one annotation with at least one portion of the object;

- a database that stores an object identifier, the at least one annotation and the link; and
- a synchronize circuit that associates the at least one annotation and the link with the object identifier, wherein the object identifier corresponds to the at least one object, and a viewing medium of the at least one object is distinct from the annotation device.

Rivette318 discloses an annotation device, the annotation device comprising:

- an input device that receives at least one annotation (an input text ... using the keyboard; col.41, lines 57-65);
- a database (note database 8702; col.42, lines 56-67) that stores an object identifier (a patent identifier box 355; col.33, lines 26-56), the at least one annotation (annotations; Abstract) and the link; and
- a synchronize circuit (the text and image files are synchronized; Abstract) that associates the at least one annotation and the link with the object identifier, wherein the object identifier corresponds to the at least one object, and a viewing medium (display screen 68; col.14, line 18) of the at least one object is distinct from the annotation device (Fig.3).

However, Rivette318 is silent on “an annotation linking circuit that establishes a link associating the at least one annotation with at least one portion of the object.”

Rivette434 discloses an annotation linking circuit that establishes a link associating the at least one annotation with at least one portion of the object (link sub-notes to portions of data object; col.11, lines 1-67 & automatically and permanently linking ... said annotation to at least portion of a data object; col.39, lines 56-57).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Rivette434 with Rivette318 because it would

have provided the enhanced capability for conveying contextual information explaining the rationale for such organization, association, as well as the user's thoughts regarding the data objects.

Dependent claims 2-5 include the same limitations as in claims 15-18, and are similarly rejected under the same rationale.

As to dependent claim 6, Rivette318 discloses the search circuit is located in at least one of the annotation device, a personal computer and a networked search engine (col.10, lines 24-32).

As to dependent claim 7, Rivette318 discloses the search circuit receives at least one of the object identifier and one or more key words corresponding to the object to be annotated (col.30, lines 1-4/ col.31, lines 1-22 & Fig.24-25)

As to dependent claim 8, Rivette318 discloses an annotation database that stores the at least one annotation and the object identifier for the at least one object (col.42, lines 56-62 & Fig.87).

As to dependent claim 9, Rivette 318 discloses the annotation database is located on a distributed network (col.10, lines 24-32).

As to dependent claim 10, Rivette318 discloses the annotation database stores at least one annotation previously associated with the at least one object (col.43, lines 2-20 & Fig. 87).

As to dependent claim 11 includes the same limitations as in claim 25, and is similarly rejected under the same rationale.

As to dependent claim 12, Rivette318 discloses the annotation device (Fig.3) is a portable device.

As to dependent claim 13, Rivette318 discloses the object identifier is collocated with the at least one object (col.43, lines 50-67).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| | | |
|-------------------|--------------------------|-----------------------------|
| Rivette et al. | U.S Patent No. 5,845,301 | issued dated: Dec. 1, 1998 |
| Rivette et al. | U.S Patent No. 5,806,079 | issued dated: Sep. 8, 1998 |
| Rivette et al. | U.S Patent No. 6,389,434 | issued dated: May 14, 2002 |
| Ruedisueli et al. | U.S Patent No. 5,838,819 | issued dated: Nov. 17, 1998 |
| Anderson et al. | U.S Patent No. 5,537,526 | issued dated: Jul.16, 1996 |

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhahan Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.
OFFICIAL faxes must be signed and sent to (703) 746-7239.
NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhahan Nguyen
March 19, 2003

Joseph H. Feild
JOSEPH H. FEILD
PRIMARY EXAMINER